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PATENT APPLICATION

ATTORNEY DOCKET NO. 10011539-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael T. Brown

Confirmation No.: 2034

Application No.: 09/839,771

Examiner: Nguyen, Trong

Filing Date: 4-20-01

Group Art Unit: 2152

Title: System and Method for Sharing Contact Information

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 10-5-05

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

(a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

1st Month
\$120

2nd Month
\$450

3rd Month
\$1020

4th Month
\$1590

The extension fee has already been filed in this application.

(b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Michael T. Brown

By David Rodack, Esq.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael T. Brown

Group Art Unit: 2152

Serial No.: 09/839,771

Examiner: Nguyen, Trong

Filed: April 20, 2001

Docket No. 10011539-1

For: **System and Method for Sharing Contact Information**

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief under 37 C.F.R. § 41.37 is submitted in support of the Notice of Appeal filed October 5, 2005, responding to the Final Office Action mailed June 17, 2005.

It is not believed that extensions of time or fees are required to consider this Appeal Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account No. 08-2025.

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I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

There are no known related appeals or interferences that will affect or be affected by a decision in this Appeal.

III. Status of Claims

Claims 1-7, 14-17, and 21-23 stand finally rejected. No claims have been allowed. The final rejections of claims 1-7, 14-17, and 21-23 are appealed.

IV. Status of Amendments

This application was originally filed on April 20, 2001, with twenty (20) claims. In a Preliminary Amendment filed September 25, 2001, Applicant amended claim 15. In a Response filed January 4, 2005, Applicant amended claims 1, 2, 4-7, and 14-16, canceled claims 8-13 and 18-20, and added new claims 21-25.

All of the above-identified amendments have been entered and no other amendments have been made to any of claims 1-7, 14-17, and 21-23. The claims in the attached Claims Appendix (see below) reflect the present state of those claims.

V. Summary of Claimed Subject Matter

The claimed inventions are summarized below with reference numerals and references to the written description (“specification”) and drawings. The subject matter described in the following appears in the original disclosure at least where indicated, and may further appear in other places within the original disclosure.

Independent claim 1 describes a method for sharing contact information. The method comprises storing a user’s contact information in a publicly-accessible database that is accessed over a network. Applicant’s specification, page 9, lines 19-21; page 11, lines 5-8; Figure 2, item 218; Figure 3, item 316.

The method of claim 1 further comprises receiving identification from the user of a person that the user authorizes to access the user’s contact information. Applicant’s specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The method of claim 1 further comprises receiving a request from the authorized person to access the user’s contact information. Applicant’s specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The method of claim 1 further comprises transmitting the user’s contact information to a computing device of the authorized person from the database via the network in response to the request. Applicant’s specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

Independent claim 14 describes a method for sharing contact information. The method of claim 14 comprises storing a user's contact information in a web server accessible via the Internet. Applicant's specification, page 9, lines 19-21; page 11, lines 5-8; Figure 2, item 218; Figure 3, item 316.

The system of claim 14 further comprises receiving from the user an identification of one or more persons that the user authorizes to access the user's contact information. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The system of claim 14 further comprises receiving identification of what pieces of contact information to share with each authorized person. Applicant's specification, page 15, lines 3-16; Figure 4, item 412.

The system of claim 14 further comprises receiving a request from a person to view the user's contact information. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The system of claim 14 further comprises verifying authorization of the person to view the user's contact information and the level of access for which the person is approved. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The system of claim 14 further comprises transmitting to the person only the pieces of contact information that the person is authorized to view. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

Independent claim 15 describes a system for sharing contact information. The system comprises means for storing a user's contact information in a location that is

publicly-accessible over a network. Applicant's specification, page 9, lines 19-21; page 11, lines 5-8; Figure 2, item 218; Figure 3, item 316.

The system of claim 15 further comprises means for receiving an identification of one or more persons that a user authorizes to access the user's contact information. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The system of claim 15 further comprises means for receiving requests from persons to access the user's contact information. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

The system of claim 15 further comprises means for transmitting the user's contact information to computing devices of authorized persons from the database in response to the requests. Applicant's specification, page 14, line 18 to page 15, line 6; Figure 4, items 408 and 410.

VI. Grounds of Rejection to be Reviewed on Appeal

The following ground of rejection is to be reviewed on appeal:

1. Claims 1-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Adamson (U.S. Pat. No. 5,818,442).

VII. Arguments

The Appellant respectfully submits that Applicant's claims are not indefinite under 35 U.S.C. § 112, second paragraph, or obvious under 35 U.S.C. § 103, and respectfully requests that the Board of Patent Appeals overturn the final rejections of those claims at least for the reasons discussed below.

I. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. In particular, the Examiner states that the phrase "receiving identification from the user of a person that the user authorizes to access the user's contact information" in claim 1 is indefinite. Applicant disagrees.

In claim 1, two different parties are clearly defined, a "user" and a "person". Applicant believes that the identities of these parties are clear from the context of claim 1, and Applicant's disclosure, and therefore has not amended claim 1. Accordingly, Applicant requests that the rejection be overturned.

In the interest in facilitating allowance of the instant application, Applicant is willing to amend the above-noted phrase to "receiving from the user identification of a person that the user authorizes to access the user's contact information", if the Board believes that this phrase is more appropriate.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown (U.S. Pub. No. 2002/0156895) in view of Adamson (U.S. Pat. No. 5,818,442). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant’s disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the prior art teachings to include those limitations.

A. Claims 1-7 and 21-23

Independent claim 1 provides as follows (emphasis added):

1. A method for sharing contact information, comprising:
storing a user's contact information *in a publicly-accessible database that is accessed over a network;*
receiving identification from the user of a person that the user authorizes to access the user's contact information;
receiving a request from the authorized person to access the user's contact information; and
transmitting the user's contact information to a computing device of the authorized person from the database via the network in response to the request.

During prosecution, the Examiner argued that Applicant admits that it is known to store a user's contact information in a publicly-accessible database that is accessed over a network. The Examiner admitted, however, that Applicant does not admit that known is "receiving an identification and request from an authorized user to access contact data and exchanging contact information between authorized users." However, the Examiner argues that Adamson teaches such receiving, requesting, and exchanging and, in view of that teaching, Applicant's claim 1 would have been obvious.

Irrespective of whether Applicant admits or does not admit that it is known to store contact information in a publicly-accessible database, Applicant asserts that there is *no* motivation provided by the prior art to combine the teachings of Adamson with the so-called admissions of Applicant. As was noted during prosecution, *Adamson only*

discloses storing contact information in relation to a general purpose electronic conference (GPEC) application that is accessible only to participants of an electronic conference. Adamson, column 7, lines 10-28. There is simply no suggestion in the prior art that aspects of Adamson's electronic conferencing system can or should be added to a publicly-accessible database that stores contact information. Clearly, the only such suggestion is provided by Applicant's own disclosure of the claimed invention (which explicitly teaches controlling access to such contact information). As is well established in the law, such hindsight to the Applicant's own disclosure is improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention). Given that no such motivation or suggestion is provided by the prior art, it appears that the proposed combination was made to simply satisfy each of Applicant's claim limitations without regard for the propriety of that combination. For at least the foregoing reasons, the rejection should be withdrawn.

Even if the Adamson teachings were properly combinable with Applicant's so-called admitted prior art, such combination would *still* not result in Applicant's claimed invention. Specifically, there is no teaching in Applicant's "admitted" prior art or the Adamson reference as to *how* aspects of Adamson's system could be integrated with the system of the "admitted" prior art. Again, the "admitted" prior art teaches a publicly-accessible database of contact information, while Adamson teaches an *electronic conferencing system*. Adamson's "control" over access to contact information merely relates to gaining access to the conference. Once such access is obtained, *no further*

measures are required to access the contact information. Such a control scheme simply does not fit within the system of the “admitted” prior art, and the Adamson reference contains no indication as to how to transform Adamson’s control scheme to suit the “admitted” prior art system.

With particular regard to dependent claim 4, Adamson does not teach or suggest receiving an “email address” as an “identification” of a person that the user “authorizes to access the user’s contact information”. In the Adamson system, authorization to join a conference does not comprise providing an “email address” as an “identification”.

Regarding dependent claim 5, Adamson does not teach or suggest adding a person’s identity to an “approved list”.

Regarding dependent claim 6, Adamson does not teach or suggest “receiving an indication from the user as to *what pieces* of contact information to make accessible”. In the Adamson system, conference participants obtain *all* available contact information of the user once joining the conference. No distinctions are made as to which “pieces” of information a conference participant may access.

Regarding dependent claim 21, Adamson does not teach or suggest “receiving an indication as to which of *multiple groups of information* to make accessible to the authorized person”. Applicant notes that the Examiner did not address this limitation and instead merely indicated that it is obvious for the same reasons as claim 6 (which does not comprise the limitation). Adamson only describes sharing of a business card. *Nowhere* is it stated that different groups of information (e.g., different business cards) of the same person can be shared.

Regarding dependent claims 21 and 23, Adamson does not teach or suggest a “personal information group”, a “business information group”, or “manual selection of each piece of information to make accessible to the authorized person”. Again, Adamson identifies no such different groups.

B. Claim 14

Independent claim 14 provides as follows (emphasis added):

14. A method for sharing contact information, comprising:
storing a user's contact information in a web server accessible via the Internet;
receiving from the user an identification of one or more persons that the user authorizes to access the user's contact information;
receiving identification of what pieces of contact information to share with each authorized person;
receiving a request from a person to view the user's contact information;
verifying authorization of the person to view the user's contact information and the level of access for which the person is approved;
and
transmitting to the person only the pieces of contact information that the person is authorized to view.

Regarding claim 14, Adamson does not teach or suggest “receiving identification of what pieces of contact information to share with each authorized person” or “transmitting to the person only the pieces of contact information that the person is authorized to view” for reasons described in the foregoing. Moreover, Adamson does not

teach or suggest “verifying authorization of the person to view the user’s contact information and the level of access for which the person is approved”. In fact, Adamson does not even mention any “level of access”.

C. Claims 15-17

Independent claim 15 provides as follows (emphasis added):

15. A system for sharing contact information, comprising:
means for storing a user’s contact information in a location that is publicly-accessible over a network;
means for receiving an identification of one or more persons that a user authorizes to access the user’s contact information;
means for receiving requests from persons to access the user’s contact information; and
means for transmitting the user’s contact information to computing devices of authorized persons from the database in response to the requests.

Regarding claim 15, Adamson does not teach “means for storing a user’s contact information in a location that is publicly-accessible over a network” or “means for receiving an identification of one or more persons that a user authorizes to access the user’s contact information” for reasons described in the foregoing.

D. Conclusion

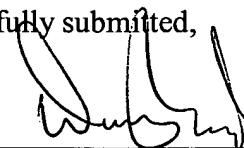
In summary, it is Applicant’s position that Applicant’s claims are patentable and that the rejection of these claims should be overturned.

VII. Conclusion

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,

By:



David Rodack
Registration No. 47,034

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Claims Appendix under 37 C.F.R. § 41.37(c)(1)(viii)

The following are the claims that are involved in this Appeal.

1. A method for sharing contact information, comprising:
 - storing a user's contact information in a publicly-accessible database that is accessed over a network;
 - receiving identification from the user of a person that the user authorizes to access the user's contact information;
 - receiving a request from the authorized person to access the user's contact information; and
 - transmitting the user's contact information to a computing device of the authorized person from the database via the network in response to the request.
2. The method of claim 1, wherein storing the user's contact information comprises storing the user's contact information on a network server accessible through the network that is used as a central repository of contacts information.
3. (Original) The method of claim 2, wherein the network comprises the Internet.
4. The method of claim 1, wherein receiving identification comprises receiving the person's email address.

5. The method of claim 1, wherein enabling the person to access the user's contact information comprises adding the person's identity to an approved list associated with the user's contact information.

6. The method of claim 1, further comprising receiving an indication from the user as to what pieces of contact information to make accessible to the authorized person.

7. The method of claim 1, further comprising revoking a person's access to the user's contact information in response to the user's request to revoke the access.

8-13. (Canceled)

14. A method for sharing contact information, comprising:
storing a user's contact information in a web server accessible via the Internet;
receiving from the user an identification of one or more persons that the user authorizes to access the user's contact information;
receiving identification of what pieces of contact information to share with each authorized person;
receiving a request from a person to view the user's contact information;
verifying authorization of the person to view the user's contact information and the level of access for which the person is approved; and

transmitting to the person only the pieces of contact information that the person is authorized to view.

15. A system for sharing contact information, comprising:

means for storing a user's contact information in a location that is publicly-accessible over a network;

means for receiving an identification of one or more persons that a user authorizes to access the user's contact information;

means for receiving requests from persons to access the user's contact information; and

means for transmitting the user's contact information to computing devices of authorized persons from the database in response to the requests.

16. The system of claim 15, further comprising means for receiving an indication from the user as to what pieces of contact information to make accessible to the persons.

17. (Original) The system of claim 15, further comprising means for revoking a person's access to the user's contact information.

18-20. (Canceled)

21. The method of claim 6, wherein receiving an indication as to what pieces of contact information to make accessible comprises receiving an indication as to which of multiple groups of information to make accessible to the authorized person.

22. The method of claim 21, wherein receiving an indication as to which of multiple groups of information to make accessible comprises receiving an indication as to which of a personal information group and a business information group to make accessible to the authorized person.

23. The method of claim 6, wherein receiving an indication as to what pieces of contact information to make accessible comprises receiving manual selection of each piece of information to make accessible to the authorized person.

24. A method, comprising:
presenting a user with a list of links, each link identifying a person for which contact information is stored within a virtual address book;
receiving selection of one of the links; and
retrieving contact information from a remote location via a network, the contact information being the contact information for a person identified by the selected link.

25. A virtual address book application stored on a computer-readable medium, the application comprising:

logic configured to present a user with a list of links, each link identifying a person for which contact information is stored within a virtual address book;

logic configured to receive selection of one of the links; and

logic configured to retrieve contact information from a remote location via a network, the contact information being the contact information for a person identified by the selected link.

Evidence Appendix under 37 C.F.R. § 41.37(c)(1)(ix)

There is no extrinsic evidence to be considered in this Appeal. Therefore, no evidence is presented in this Appendix.

Related Proceedings Appendix under 37 C.F.R. § 41.37(c)(1)(x)

There are no related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.